Render Prior Art Unsatisfactory for Intended Purpose) it is the applicant's position that the amended claims have now been traversed because the combination of prior art references would be inappropriate for the amended claims.

In particular, the applicant notes that Gress in its entirety would teach away from the amended claims because Gress teaches away from using a human operator. Further, as Gress teaches away from using a human operator Gress also teaches away the combination of Gress and McLaughlin as a valid prior art reference.

Gress describes its invention as addressing "the need for integrating SMS messaging within the unified messaging scheme" [Gress, 0007]. The only unified messaging scheme identified in Gress being a commercially-available Cisco Unified Open Network Exchange (hereinafter "Cisco uOne") system [Gress, 0020]. Further"[i]n particular, the disclosed embodiment contemplates enhancing the existing Cisco uOne system by addition within the unified messaging system 20 of an SMS module" [Gress, 0021]. Accordingly Gress only describes a Cisco uOne system, i.e. a microprocessor-based unified messaging system using automated speech recognition (ASR) programs and procedures. Beyond this Gress provides no further information or teachings about how the speech to text conversion process actually works. Accordingly not only does Gress fail to anticipate the applicant's invention, it also teaches away from the current invention. As stated in MPEP 2145 X.C. a prima facia case of obviousness "may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention." *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997).

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In addition as Gress only teaches the addition of an SMS module to a computer or microprocessor based unified messaging system Gress also teaches away from combining with McLaughlin. McLaughlin describes methods that use human operators for transcribing speech using specialized public switched telephone network modems [McLaughlin, 0209-0212]; but Gress teaches away from using these methods. Gress describes the problem of providing enhanced services over public switched telephone networks as one that "can only be done by switch vendors that have sufficient know-how of the existing public switched telephone network infrastructure". Further Gress describes its invention of "a unified communications system implemented independent of the existing proprietary voice mail systems" as enabling "service providers to use scalable and distributed systems using recognized communication protocols" [Gress, 0007]. Accordingly, Gress teaches away from being combined with McLaughlin. As stated in MPEP 2145 X.D. "[i]t is improper to combine references when the references teach away from their combination." *In re Grasselli,* 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Circ. 1983) and "[k]nown disadvantages in old devices which would naturally discourage search for new inventions may be taken into account in determining obviousness." *United States v. Adams,* 383 U.S. 39, 52, 148 USPQ 479, 484 (1966).

Response to 103(a) obviousness rejections to claim 3

In response to the Examiner's 103(a) obviousness rejections to claim 3 based on Gress and McLaughlin and in further view of Martin (U.S. Patent 6,606,373) the applicant has amended claim 1 to define the operator to be a <u>human</u> operator. As stated above it is applicant's

position that Gress teaches away from using a human operator and accordingly Gress also teaches away from combining with McLaughlin.

Accordingly the applicant respectfully requests that the Examiner's previous 103(a) obviousness rejection to claim 3 has been traversed by the enclosed amendments.

Applicant's response to obviousness issues following KSR v. Teleflex

Further applicant respectfully submits the following to address the obviousness issues arising as a result of the recent US Supreme Court decision, *KSR International Co. v. Teleflex Inc.,* 550 U.S. __, 82 USPQ2d 385 (2007) (hereinafter "*KSR*") which at its outset defines the analysis for determining obviousness as follows:

> "Section 103 forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. "

> In *Graham v. John Deere Co. of Kansas City*, 383 U. S. 1 (1966), the Court set out a framework for applying the statutory language of §103, language itself based on the logic of the earlier decision in *Hotchkiss v. Greenwood*, 11 How. 248 (1851), and its progeny. See 383 U. S., at 15–17. The analysis is objective:

> > "Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be

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ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." *Id.*, at 17–18.

While the sequence of these questions might be reordered in any particular case, the factors continue to define the inquiry that controls. If a court, or patent examiner, conducts this analysis and concludes the claimed subject matter was obvious, the claim is invalid under §103." *KSR International Co. v. Teleflex Inc.*, 550 U.S. __, __, 82 USPQ2d __, 385 (2007).

In addition the US Supreme Court further stated that "the principles laid down in *Graham* reaffirmed the "functional approach" of *Hotchkiss*, 11 How. 248. See 383 U. S., at 12. To this end, *Graham* set forth a broad inquiry and invited courts, where appropriate, to look at any secondary considerations that would prove instructive. *Id.*, at 17." *KSR International Co. v. Teleflex Inc.*, 550 U.S. __, __, 82 USPQ2d __, 385 (2007).

Accordingly the applicant hereby respectfully observes that in the examiner's broad inquiry into the question of obviousness or nonobviousness the examiner must look at any secondary considerations (i.e. commercial success, long felt but unsolved needs, failure of others, etc.) that would prove instructive.

As shown by the evidence provided in the enclosed Affidavit of Daniel Michael Doulton the amended claims are fundamental to the core business of SpinVox Limited (37 CFR 1.132 Affidavit of Daniel Michael Doulton (hereinafter "Aff. of Doulton") cl. 3).
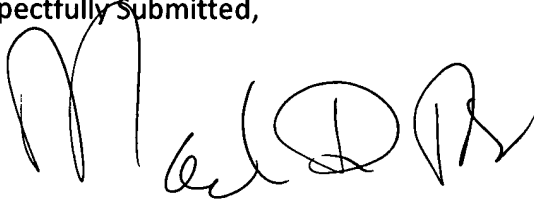
In March 2008 SpinVox Limited received an additional $100 million in funding from private investors (see para 1 of the Reuters, March 19, 2008 article identified in Aff. of Doulton at cl. 4 (hereinafter "Reuters")) doubling the total investment in SpinVox Limited to $200 million (Reuters, para 12). SpinVox Limited also has a valuation in excess of $500 million (Reuters, para 2) and has deals with at least 12 cellphone carriers globally including Alltel Wireless, the fifth-largest US carrier (Reuters, para 4).

The long-felt need of the benefits arising transcribing voice mail messages to text has been recognized in the marketplace (see pages 1-3 of the New York Times, February 15, 2007 article identified in Aff. of Doulton, cl. 5 (hereinafter "NY Times")). Further these services are being provided by companies that arrived to the market after SpinVox (page 1, para 4 and page 2, paras 6-7, NY Times).

On the basis of this evidence which clearly demonstrates the success of the current claimed invention in the marketplace, it is applicant's position that the secondary considerations of commercial success, long-felt need and copying by others, as shown in the evidence provided clearly demonstrates the nonobviousness of the amended claims 1-21.

In conclusion, for the reasons above the applicant now respectfully requests that claims 1-21 should be allowed.

Respectfully Submitted,

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